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09/618,924	07/18/2000	Scott E. Lilienthal	SEL1	8587

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EXAMINER

KOVALICK, VINCENT E

ART UNIT

PAPER NUMBER

2673

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/618,924

Applicant(s)

LILIENTHAL, SCOTT E. 

Examiner

Vincent E Kovalick

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-5, 7-9 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, and 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2673

### DETAILED ACTION

1. This Office Action is in response to Applicant's Amendment dated October 7, 2002 in response to PTO Office Action dated June 5, 2002. The cancellation of claims 6, 10 and 11 and the amendments to claims 1, 7, 8, 13 and 17-20 have been entered in the record and result in the action as indicated hereinbelow. The amendments to claims 1 and 19, render Applicant's remarks moot.

#### *Claim Rejections - 35 U.S.C. § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-5 and 7-8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton (USP 4,985,697) taken with Simone (USP 4,997,374).

Relatively to claim 1, Boulton **teaches** an electronic book device related to methods for presenting educational training material (col. 2, lines 39-68; col. 3, lines 1-67; col. 4, lines 1-54; Fig. 8 and Abstract). Boulton further teaches a portable paper less book (col. 2, lines 39-41

Art Unit: 2673

and Fig. 8) comprising a digital storage device for visual and audible information (col. 2, lines 24-36).

Boulton **does not teach** said portable paper less book including a display system for displaying visual and audible information from a digital storage device wherein the visual and audible information is a printed book which appears on the visual display and the printed words are simultaneously read in the visual display.

Simone **teaches** teaching a teaching device for assisting a child in learning to read (col. 1, lines 6-68; col. 2, lines 1-68; col. 3, lines 1-27 and Fig. 2); Simone further **teaches** display system for displaying visual and audible information from a digital storage device wherein the visual and audible information is a printed book which appears on the visual display and the printed words are simultaneously read in the visual display (col. 1, lines 53-63; col. 2, lines 5-10 and 14-18; col. 3, lines 63-67; col. 1, lines 1-5 and Fig. 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate in the device as taught by Boulton the features as taught by Simone, as suggested by Boulton (col. 20, lines 13-20), in that said features would link together the visual word/s and the sound/s of said words for presentation simultaneously giving the user visual form of the word coupled with the actual sound of the word as it is being viewed, making it a more effective teaching/learning tool.

Regarding claim 2, Simone **teaches** a paperless book wherein the display of visual information is a light emitting diode (col. 3, lines 5-9 and 14-18 and col. 5, lines-63).

Art Unit: 2673

Regarding claim 4, Boulton **teaches** said paperless book wherein the display of visual information is in a screen on the paperless book (col. 9, lines 67-68 and col. 10, line 1).

Regarding claim 5, Simone **teaches** said paperless book wherein the audio information display is produced by a speaker permanently attached to the paperless book (col 3, lines 55-56 and Fig. 1, item 28).

Regarding claim 7, Simone **teaches** said paperless book wherein the audible display of the information is generated by artificial speech (col. 4, lines 20-26).

Relative to claim 8, it would have been obvious to a person of ordinary skill in the art at the time of the invention that the said paperless book would comprising a switch which activates and deactivates the visual and audible displays in that on/off switches are an inherent part of electrically powered devices.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton taken with Simone as applied to claim 1 in item 3 hereinabove, and further in view of Fukumoto et al. (USP 6,380,923).

Relative to claim 3, Boulton taken with Simone **does not teach** said paperless book wherein the display of visual information is in a head-mounted display.

Fukumoto et al. **teaches** said paperless book wherein the display of visual information is in a head-mounted display (col. 17, lines 53-55 and col. 19, lines 33-40).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate in the device as taught by Boulton taken with Simone the feature as taught by

Art Unit: 2673

Fukumoto et al. in order to expand the adaptability of the system to a larger number of applications.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton taken with Simone as applied to claim 1 in item 3 hereinabove, and further in view of Reavey et al. (USP 5,847,698).

Relative to claim 9, Boulton taken with Simone **does not teach** a paperless book comprising an electronic bookmark.

Reavey et al. **teaches** a electronic book device (col. 2, lines 66-67; col. 3, lines 1-67 and col. 4, lines 1-11); Reavey further **teaches** a paperless book comprising an electronic bookmark (col. 9, lines 5-6).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate in the device at taught by Boulton taken with Simone the feature of adding an electronic bookmark feature in that it is a feature commonly used in paper books and facilitates a simple way of marking the page to which a reader may want to return.

6. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton taken with Simone as applied to claim 1 in item 3 hereinabove, and further in view of Ohara et al. (USP 6,297,812).

Relative to claims 12 and 15, Boulton taken with Simone **does not teach** said paperless book wherein the digital storage device is a ROM selected from the group of ROM devices consisting

Art Unit: 2673

of floppy disk, CD-ROM disk and DVD disk; or a control which determines at which point in the sequence of visual and aural information the process of displaying the visual and audible information will begin.

Ohara et al. **teaches** an information display system for electronically reading a book (col. 1, lines 57-67 and col 2, lines 1-67). Ohara et al. further **teaches** paperless book wherein the digital storage device is a ROM (it being understood that ROM devices include floppy disks, CD-ROM disks and DVD disks). Still further, Ohara et al. **teaches** a control which determines at which point in the sequence of visual and aural information the process of displaying the visual and audible information will begin (col. 4, lines 50-67 and Abstract).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate in the device as taught by Boulton taken with Simone the feature as taught by Ohara et al. in order to expand the adaptability of the system to incorporate a larger number data memory devices; and to incorporate the feature that will permit the user to determine a which point in the visual and audible information the display process will begin.

7. Claim 13 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton taken with Simone as applied to claim 1 in item 3 hereinabove, and further in view of Eberhard et al. (USP 6,331,867).

Relative to claim 13, Boulton taken with Simone **does not teach** said paperless book wherein a highlighted portion of the text indicates an associated visual or aural file.

Art Unit: 2673

Eberhard et al. **teaches** an electronic book with automated look-up of terms within reference titles (col. 1, lines 42-67 and col. 2, lines 1-47). Eberhard et al. further **teaches** said paperless book wherein a highlighted portion of the text indicates an associated visual or aural file (col. 2, lines 16-19).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate in the device as taught by Boulton taken with Simone the feature as taught by Eberhard et al. in order to incorporate the feature that will permit the user to identify specific portions of the visual and audible information being displayed to be operated on.

8. Claim 14 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton taken with Simone as applied to claim 1 in item 3 hereinabove, and further in view of Nobles et al.(USP 4,820,167).

Relative to claim 14, Boulton taken with Simone **does not teach** said paperless book comprising controls which control the speed at which the visual and aural information is scrolled.

Nobles et al. **teaches** an electronic school teaching system (col. 1, lines 56-68; col. 2, lines 1-68; col. 3, lines 1-68 and col. 4, lines 1- 25). Nobles et al. further **teaches** said paperless book comprising controls which control the speed at which the visual and aural information is scrolled (col. 5, lines 46-47).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate in the device as taught by Boulton taken with Simone the feature as taught by Nobles et al. in order to expand the functionality of the paperless book.



Art Unit: 2673

9. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reavey et al. taken with Wong (Des. 326,446) in view of Hyman et al. (USP 5,495,557).

Relative to claim 16, Reavey et al. **teaches** a paperless book comprising : a housing (col. 4, lines 48-55), a central processing unit and a battery (col. 4, lines 39-55).

Reavey et al. **does not teach** said paperless book comprising a ROM reader, permanent memory unit and temporary memory unit mounted within the housing; or a power jack, head-mounted visual display housing jack, aural display housing jack, scroll button, select button, play button, stop or pause button, directional control buttons, volume control dial, door for inserting ROM, and should strap, mounted on the housing, earphones, connecting wires and a earphone jack, the earphone jack connected to the aural display housing jack, a head-mounted visual display, connecting wire, and visual display jack, the visual display jack connected to the head-mounted visual display housing jack.

Wong **teaches** a combined electronic book and CD ROM reader (front page description and Fig. 1).

Reavey et al. taken with Wong **does not teach** said paperless book including permanent memory unit, and temporary memory unit mounted within the housing, or a power jack, head-mounted visual display housing jack, aural display housing jack, scroll button, select button, play button, stop or pause button, directional control buttons, volume control dial, door for inserting ROM, and should strap, mounted on the housing, earphones, connecting wires and a earphone jack, the

Art Unit: 2673

earphone jack connected to the aural display housing jack, a head-mounted visual display, connecting wire, and visual display jack, the visual display jack connected to the head-mounted visual display housing jack.

Hyman et al. **teaches** an electronic toy for forming sentences (col. 1, lines 32-67 and col. 2, lines 1-2). Hyman et al. further **teaches** a permanent memory unit, and temporary memory unit mounted within the housing (col. 1, lines 11-14 and 32-62).

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the system would include various combinations of connected to the head-mounted visual display housing jack, in that various combinations of these elements would be required by the system to make it operational, said elements being well known the art.

It would have been further obvious to a person of ordinary skill in the art at the time of the invention to incorporate in the device as taught by Reavey et al. taken Wong in view of Hyman et al. in order to incorporate in the system data storage (permanent and temporary) and control logic necessary to make the system operational and fit the application for which it is intended.

Regarding claim 17, it would have been obvious to a person of ordinary skill in the art at the time of the invention that the paperless book would comprise a alternating current to direct current convertor which plugs into the power jack and provides direct power to the paperless book in that it would be a system requirement to power the paperless book with DC power.

Relative to claim 18, it would have been obvious to a person of ordinary skill in the art at the time of the invention that the system would have to have a provision for storing visual and audio

Art Unit: 2673

information in order to process the and coordinate the visual data with the corresponding audio data; with the understanding that the system would have to provide the means to insert the ROM units (e.g. a ROM loading door).

10. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton. Relative to claim 19, Boulton **teaches** the process of simultaneously displaying both visual and audible information from a digital storage device (col. 20, lines 13-20), wherein the visual and audible information is a printed book which appears on the visual display and the printed words are simultaneously read in the audible display (col. 9, lines 62-68 and col. 10, line 1), comprising the steps: a. downloading visual and audible information from a removable memory storage device, a computer, or a global computer network into a temporary storage site (col. 3, lines 7-20); b. displaying a page of printed words from the temporary storage site on visual a display, (col. 3, lines 7-20), and c. displaying audible expression of the page of printed words of step b from the temporary storage site on an audible display, the display of audible material simultaneously with the display of visual material (col. 9, lines 65-67 and col. 20, lines 19-20). The **difference** between the teaching of the instant invention and that of the prior art of record is that said prior art of record **does not teach** downloading visual and audible information from a computer or a global computer network into a temporary storage site; though it **does teach** downloading from a removable memory storage device.

It would have been obvious to a person of ordinary skill in the art at the time of the invention

Art Unit: 2673

that the apparatus as taught by Boulton **teaches** the limitation of claim 19 of the instant invention.

Regarding claim 20, Bolton **teaches** the process wherein the visual and aural information is downloaded from a removable memory storage device (col. 3, lines 7-20). It being understood that the external memory media could consist of a removable memory storage device.

11. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton as applied to claim 19 in item 10 hereinabove, and further in view of Reavey et al. (USP 5,847,698) Relative to claim 21, Boulton **does not teach** advancing the visual display to the next page when the audible display corresponding to the displayed page is completed.

Reavey et al. **teaches** an electronic book device (col. 2, lines 66-67; col. 3, lines 1-67 and col. 4, lines 1-11). Reavey et al. further **teaches** advancing the visual display to the next page when the audible display corresponding to the displayed page is completed (col.7, lines 13-22 and Fig. 20).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate in the device as taught by Boulton the additional feature as taught by Reavey et al in order to facilitate advancing through the pages of the paperless book.

Art Unit: 2673

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. .

U. S. Patent No.	6,384,808	Azami
U. S. Patent No.	6,243,071	Shwartz
U. S. Patent No.	6,021,306	McTaggart
U. S. Patent No.	5,893,132	Huffman et al.
U. S. Patent No.	5,239,665	Tsuchiya
U. S. Patent No.	5,631,883	Li

Art Unit: 2673

***Responses***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Vincent E. Kovalick** whose telephone number is **(703) 306-3020**. The examiner can normally be reached Monday-Thursday from 9:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Bipin Shalwala**, can be reached at **(703) 305-4938**.

**Any response to this action should be mailed to:**

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Washington, D.C. 20231

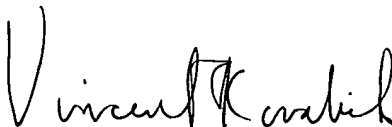
**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

***Inquires***

14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is **(703) 306-0377**.

  
Vincent E. Kovalick